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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Roland Cherif Cherif Cheikh

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06/24/2009

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EXAMINER

DESANTO, MATTHEW F

ART UNIT

PAPER NUMBER

3763

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/787,508	Applicant(s) CHERIF CHEIKH ET AL.	
	Examiner MATTHEW F. DESANTO	Art Unit 3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45-47 and 49-90 is/are pending in the application.
- 4a) Of the above claim(s) 56 and 58-86 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 45-47, 49-55 and 87-90 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 45, 89 are rejected under 35 U.S.C. 102(b) as being anticipated by Higgins (USPN 3,110,309).

Higgins discloses a syringe with a reservoir (10), a piston (35), a needle (29), and wherein the needle is fastened to the reservoir by direct application of the element forming the reservoir against the base by a support or casing which houses said element forming the reservoir. The casing being reference number 40. The needle is in a fixed engagement in figure 2 (Figures 1, 2 and entire reference).

The examiner would like to note that a second interpretation could be used with Higgins from figure 2, if you construe the reservoir as 40 and is held into place with the casing (131), with the needle and piston still being the same reference numbers.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 45, 46, 47, 49, 50, 51, 52, 87, 88, 89, 90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamashita (55-7352).

5. Yamashita discloses a syringe with a reservoir formed by a hollow element (11), a piston (P), needle (13), and wherein the needle is fastened to the reservoir by direct application of the element forming the reservoir against the base (shown in figure 2, 4) by a support or casing (13) which houses said element forming the reservoir (Figures 1, 4 and 5 and entire reference), but fails to show forming a substantially zero clearance in the embodiment shown.

6. At the time of the invention it would have been obvious to modify or at least try to reduce the clearance or space between the casing and needle/reservoir element to strength and reduce the likelihood of cracking the reservoir.

7. (The examiner feels that the annular member 16 would be squeezed to virtually zero clearance but since this is not explicitly taught the examiner provides a 103 rejection and rational as to why one of ordinary skill would modify the Yamashita reference).

As to claim 45, wherein said element forming the reservoir provides mechanical resistance of the syringe (Figures 1, 4, 5 and entire reference).

With regards to claim 89, one of ordinary skill in the art would find it obvious to modify the see-through hole to include a covering because it would provide a simple manufacturing step. The examiner would also like to note that it would only take routine skill in the art for one of ordinary skill in the art to modify and change the casing structure to include a totally enclosed structure.

8. Claims 53-55, and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamashita as applied to the claims above, and further in view of Higashikawa (USPN 5704918).

With regard to claims 53-55, Yamashita meets the claim limitations as described above but fails to include the claimed dimensions. At the time of the invention, it would have been obvious to construct the device from the claimed dimensions since the Federal Circuit has held, where the only difference between the prior art and the claims was a recitation of relative dimension/size/proportion of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

With regard to claim 57;

Yamashita disclosed the claimed invention but fails to disclose wherein the tubular reservoir has more than two tubes.

Higashikawa disclosed an adjustable dispensing syringe with an outer cast, and two inner tubes that form inside the reservoir.

At the time of the invention it would have been obvious for a person of ordinary skill in the art to combine the disclosed invention of Yamashita with the teachings of Higashikawa because it is well known in the art to use two tubes when combining different agents being injected into the body, especially when one agent is a liquid and the other agent is a solid material.

Response to Arguments

9. Applicant's arguments filed 12/29/08 have been fully considered but they are not persuasive with regards to Higgins because Higgins teaches the casing 131 surrounding the external surface and the hollow element's end face directly contacting the needle base (in figure 2). The examiner respectfully disagrees with applicant's interpretation of the hollow element's end face because the diaphragm would be part of the hollow element, but even without that interpretation the hollow element abuts the needle base at the peripheral surfaces of the diaphragm as shown in figure 2.
10. The previous 102 Rejections based on Yamashita and DeChellis et al. have been withdrawn

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW F. DESANTO whose telephone number is (571)272-4957. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick LUCCHESI can be reached on (571) 272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Matthew DeSanto
/Matthew F DeSanto/
Primary Examiner, Art Unit 3763